

REMARKS

Upon entry of this response, claims 18-22 and 24-38 are still present in this application. Claim 18 is an independent claim directed to a method for making sports floors coverings, with the remaining claims depending therefrom.

Claims 18-22, 24-28, 30, 32-34 and 37-38 stand rejected as being anticipated by U.S. Patent No. 5,912,298 to Gomi et al.; and claims 18-22 and 24-38 also stand rejected as being obvious over U.S. Patent No. 5,912,298 to Gomi et al.

Based on the foregoing amendments and the following remarks, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections of the claims.

1. Withdrawal of Finality of Office Action

Applicants notice that the present Office Action was made final by the esteemed Examiner. Applicants disagree that the Office Action should have been made final, and respectfully request reconsideration and withdrawal of the finality of the Office Action.

On page 5 of the Office Action, the Examiner indicates that "all claims are drawn to the same invention claimed in the application prior to entry of the submission under 37 CFR 1.114 and

could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114." The Examiner cites MPEP § 706.07(b) as the basis for making the Office Action final.

However, Applicants respectfully disagree with the Examiner. Further in section 706.07(b), the MPEP states that "However, it would not be proper to make final a first Office action in a continuing or substitute application where that application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry because (A) new issues were raised that required further consideration and/or search, or (B) the issue of new matter was raised." (emphasis added).

Applicants respectfully submit that the Examiner had indicated that the amendments filed in the submission under 37 CFR 1.114 would raise new issues that required further consideration. In particular, Applicants draw the Examiner's attention to the Continuation Sheet attached to the Interview Summary form for the interview conducted on August 2, 2005. In particular, on the Continuation Sheet, the Examiner states "the proposed amendment would appear to overcome this prior art but would require further consideration and search as it is was not searched prior to final

rejection and likely would not be entered after final rejection."

Thus, the Examiner clearly indicated that the amendments would require further consideration and searching during the interview, necessitating Applicants to file a Request for Continued Examination with the response to the previous Office Action.

Accordingly, since the Examiner had indicated that the previous amendment would require further consideration and searching, it was improper for the Examiner to make the instant Office Action final. Therefore, Applicants respectfully request withdrawal of the finality of the instant Office Action.

2. Rejection of Claims 18-22 24-28, 30, 32-34 and 37-38
under 35 U.S.C. § 102 (a or e)

The Office Action states that claims 18-22, 24-28, 30, 32-34 and 37--38 are rejected under 35 U.S.C. §102 (a or e) as being anticipated by U.S. Patent No. 5,912,298 to Gomi et al. (the "298 patent") for the reasons set forth in the Office Action.

RESPONSE

Applicants respectfully traverse this rejection. The test for anticipation is whether each and every element as set forth is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2

USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131. The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP §2131. The elements must also be arranged as required by the claim. *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990). Applicants respectfully submit that the '298 patent fails to teach each of the claimed elements. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

Claim 18 is currently drawn to a method for making sports floor coverings comprising applying a formulation to a surface, said formulation comprising aqueous, isocyanate free polyurethane dispersions, wherein said dispersions have a solid matter content of ≥ 30 percent by weight and a solvent content of ≤ 10 percent by weight and wherein the polyurethane polymers of said dispersions; have a number average molecular mass of 25,000 to 100,000 Daltons, and are obtained by forming a polyurethane pre-adduct which is reacted with a lower molecular and anionic modifiable polyol with two or more hydroxy groups reactive with polyisocyanates and one or more carboxy groups inert with respect to polyisocyanates to produce a polyurethane prepolymer.

Thus, it is readily apparent that claim 18 is drawn to a method of making sports floor coverings. As has been previously indicated in the response filed on November 29, 2004, "sports floor coverings" is a term of art. Included with that submission was a copy of German Industry Standard ("Deutsche Industrienorm, DIN") No. 18035, which showed that sports floor coverings have a specific construction and must meet certain performance standards. The response filed on November 29, 2004, provides a great amount of detail regarding the construction and desirable properties with respect to sports floor coverings. On account of the specific properties required of sports floor coverings, e.g., a particular deformation and energy dissipation, wear resistance, sliding friction, and resistance to spikes, sports floor coverings are different from general floor coverings. This is amply demonstrated in the attachments to the response filed on November 29, 2004.

Further, Applicants respectfully submit that sports floor coverings are not even remotely related to the floor polish as disclosed in the '298 patent. Applicants submit that there is no connection whatsoever between compositions for floor polish and sports floor coverings. They are unrelated and, in fact, are mutually exclusive. Applicants submit that a skilled artisan would not see a connection between floor polish and sports floor

coverings. In particular, Applicants cannot find anywhere within the '298 patent a teaching of applying the floor polish compositions of the '298 patent as sports floor coverings.

Applicants submit that one of the biggest differences between the two is that the compositions for floor polish are temporarily applied to floors. Due to wear and tear, floor polish will diminish over time. Furthermore, the coatings formed by applying compositions for floor polish according to the '298 patent are required to be removable by chemical means. This is made readily apparent in column 1, lines 9-11 of the '298 patent. Unlike the floor polish coatings of the '298 patent, the sports floor coverings made in accordance with the present claims are permanent and are characterized by specific properties, such as slip resistance and excellent adhesion within the constituent layers. Therefore, Applicants submit that sports floor coverings are completely unrelated to floor polish compositions, and that one of skill in the art would not be lead to the currently claimed inventive subject matter from the teachings of the '298 patent.

In addition, the fundamentally different properties of the compositions for floor polish and sports floor coverings are readily apparent in the respective products. The compositions for floor polish in the '298 patent consist of water-borne polyurethane

resin which has been reacted with a calcium compound. It is evident from claim 6 of the '298 patent that the process for preparing the floor polish compositions comprises three steps: an emulsion of water-borne polyurethane resin is prepared; the pH of the emulsion is adjusted within a range of 4.5 to 9 by adding a base; and, the polyurethane resin is reacted with a calcium compound. The resultant floor polish compositions are characterized by a number of properties, including recoatability and removability. As discussed above, these properties are important for coatings formed by application of compositions for floor polish but undesirable for sports floor coverings.

The polyurethane dispersions used in the method of the present claims, on the other hand, differ greatly from the polyurethane resins used in the '298 patent. According to present claim 18, the solvent content of the polyurethane dispersions in the claim is less than or equal 10% by weight. In all of the Examples disclosed in the '298 patent, the solvent content is about 20% by weight. This is evident by calculating the content of the N-methylpyrrolidone and methylethylketone (see Table 1).

A further difference between the present claims and the '298 patent is that the polyurethane dispersions used in the method of the present claims are obtained by forming a polyurethane pre-

adduct which is reacted with a lower molecular and anionic modifiable polyol with two or more hydroxyl groups reactive with polyisocyanates and one or more carboxy groups inert with respect to polyisocyanates to produce a polyurethane pre-polymer. The formation of a pre-adduct is not disclosed nor taught in the '298 patent. As indicated in column 4 of the '298 patent, the polyurethane prepolymers of the patent are prepared in a type of one-pot reaction. Therefore, Applicants submit that the '298 patent fails to teach this feature of claim 18.

Accordingly, Applicants respectfully submit that the '298 patent fails to teach each element and feature of claim 18, and therefore of the claims which depend from claim 18, and thus does not anticipate claim 18. Thus, Applicants respectfully request reconsideration and withdrawal of the rejection of the claims as being anticipated by the '298 patent.

3. Rejection of Claims 18-22 and 24-38
under 35 U.S.C. § 103(a)

The Official Action states that claims 18-22 and 24-38 are rejected under 35 U.S.C. § 103(a) as being obvious in view of U.S. Patent No. 5,912,298 to Gomi et al. (the "298 patent"). The reasons for the rejection are given in the Official Action.

RESPONSE

Applicants respectfully traverse this rejection and request reconsideration and withdrawal thereof. The reference of record does not teach or suggest applicants' inventive subject matter as a whole as recited in the claims. The Examiner has failed to establish a *prima facie* case of obviousness against the presently rejected claims.

To establish a *prima facie* case of obviousness, the PTO must satisfy three requirements. First, the prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Second, the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *Amgen Inc. v. Chugai Pharm. Co.*, 18 U.S.P.Q.2d 1016, 1023 (Fed. Cir. 1991). Lastly, the prior art reference must teach or suggest all the limitations of the claims. *In re Wilson*, 165 U.S.P.Q.2d 494, 496 (C.C.P.A. 1970).

Claim 18 is currently drawn to a method for making sports floor coverings comprising applying a formulation to a surface,

said formulation comprising aqueous, isocyanate free polyurethane dispersions, wherein said dispersions have a solid matter content of ≥ 30 percent by weight and a solvent content of ≤ 10 percent by weight and wherein the polyurethane polymers of said dispersions; have a number average molecular mass of 25,000 to 100,000 Daltons, and are obtained by forming a polyurethane pre-adduct which is reacted with a lower molecular and anionic modifiable polyol with two or more hydroxy groups reactive with polyisocyanates and one or more carboxy groups inert with respect to polyisocyanates to produce a polyurethane prepolymer.

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In addition, the fundamentally different properties of the compositions for floor polish and sports floor coverings are readily apparent in the respective products. The compositions for floor polish in the '298 patent consist of water-borne polyurethane resin which has been reacted with a calcium compound. It is evident from claim 6 of the '298 patent that the process for preparing the floor polish compositions comprises three steps: an emulsion of water-borne polyurethane resin is prepared; the pH of the emulsion is adjusted within a range of 4.5 to 9 by adding a base; and, the polyurethane resin is reacted with a calcium compound. The resultant floor polish compositions are characterized by a number of properties, including recoatability and removability. As discussed above, these properties are important for coatings formed by application of compositions for floor polish but undesirable for sports floor coverings.

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Therefore, Applicants respectfully submit that the '298 patent fails to teach each and every feature of claim 18 and that the

Examiner has failed to establish a *prima facie* case of obviousness with respect to claim 18 and the claims that depend therefrom. In addition, Applicants respectfully submit that one of skill in the art would not be lead by the teachings of the '298 patent to modify it in order to attempt achieving the presently claimed invention. Applicants submit that a teaching of floor polish is wholly separate from trying to construct sports floor coverings. Basis for this submission is given above with respect to the details of the specific properties of the floor polish of the '298 patent versus the sports floor coverings.

Accordingly, Applicants respectfully submit that the Examiner has failed to prove a *prima facie* case of obviousness, and that there is no motivation for a skilled artisan to modify the '298 patent. Therefore, Applicants respectfully submit that claims 18-22 and 24-38 are not obvious over the '298 patent. Applicants respectfully request the Examiner to reconsider and withdraw the rejection of claims 18-22 and 24-38.

CONCLUSION


Claims 18-22 and 24-38 are currently pending in the present application. Applicants respectfully request the Examiner to reconsider and withdraw the rejections and allow all claims pending

herein.

The Examiner is requested to contact the undersigned attorney if he has any questions or wishes to further discuss the merits of the presently pending claims.

Respectfully submitted,
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Date: January 20, 2006
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